

REMARKS

Claims 1 through 23 are pending in this application, of which claims 12 through 23 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b). Accordingly, claims 1 through 11 are active.

Claims 3 and 8 have been amended to address a formalistic issue raised by the Examiner. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 3 and 8 were rejected under the second paragraph of 35 U.S.C. §112.

In the statement of the rejection, the Examiner raised an antecedent basis issue as to whether “facets” are formed from the nitride base semiconductor layer. The Examiner further stated that the recitation “said inverse-trapezoidal convex portions” lacks antecedent basis in claim 8. This rejection is traversed.

Firstly, merely identifying a perceived antecedent basis issue does not automatically trigger the ultimate legal conclusion that a claim runs afoul of the second paragraph of 35 U.S.C. §112. *Bose Corp. v. JBL, Inc.* 61 USPQ2d 2001 (Fed. Cir. 2001). At any rate, claims 3 and 8 have been amended to address the perceived antecedent basis issue raised by the Examiner, thereby overcoming the stated basis for the imposed rejection under the second paragraph of 35 U.S.C. §112. Clearly, one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Minnesota Mining &*

Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

Applicants, therefore, submit that the imposed rejection of claims 3 and 8 under the second paragraph of 35 U.S.C. §112 is not legally viable and, hence, solicits withdrawal thereof.

Claims 1 through 11 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Kunisto et al.

This rejection is traversed. Specifically, the filing date of Kunisto et al. is October 3, 2001. However, the present invention is entitled to rely upon the foreign priority date of February 27, 2001, pursuant to 35 U.S.C. §119. Enclosed herewith is a certified English language translation of the foreign priority document, thereby enabling reliance upon the February 27, 2001 priority date anteceding the October 3, 2001 filing date of Kunisto et al. A copy of the English language translation is appended hereto as Exhibit A.

Applicants, therefore, submit that the imposed rejection of claims 1 through 11 under 35 U.S.C. 102 for lack of novelty as evidenced by Kunisto et al. is not viable and solicit withdrawal thereof.

Claims 1, 2 and 4 through 9 were provisionally rejected on the ground of double patenting of the obviousness type over claims 12 and 18 through 21 of copending Application Serial No. 09/968,886.

This rejection is traversed. Enclosed herewith as Exhibit B is a Terminal Disclaimer with respect to copending application Serial No. 09/968,886, thereby obviating the provisional rejection the ground of double patenting of the obviousness.

Based upon the foregoing, Applicants solicit withdrawal of the provisional rejection of claims 1, 2 and 4 through 9 on the ground of double patenting of the obviousness type over claims 12 and 18 through 21 of copending application Serial No. 09/968,886.

Request for Rejoinder

Applicants solicit rejoinder of non-elected method claims 12 through 23, upon the determination of an allowable device claim, pursuant to the provisions of MPEP§821.04.

Based upon the foregoing, it should be apparent that the imposed rejections have been overcome. Applicants again solicit rejoinder of non-elected method claims 12 through 23. Applicants submit that all pending are in condition for immediate allowance. Accordingly, favorable consideration is solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of

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this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'A. J. Steiner', is written over the printed name.

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